

III. REMARKS

Status of the Claims

Claims 1 and 15 are amended. Claims 11 and 16 are rewritten in independent form with all the limitations of the claims from which the formerly depended. Claims 1, and claims 11-19 are resubmitted for consideration.

Summary of the Office Action

Claims 1, 12-15, and 17-19 stand rejected under 35USC103(a) on the basis of the cited reference Jaing et al., U.S. Patent No. 6,213,651 in view of the reference Brimhall, et al, U.S. Patent No. 6,456,720. The Examiner is respectfully requested to reconsider his rejection in view of the above amendment to the claims and following remarks. Claims 11 and 16 are indicated as allowable if rewritten in independent form.

Claims 1 and 15 are amended to provide antecedent basis for the words, "said first set" in claims 11 and 16. Applicant submits that this amendment fully relieves the rejections based on 35USC112.

Claims 11 and 16 are believed allowable in accordance with the Examiner's statement in the office action.

The Invention

Claim 1 states that the components of the electro-optical device are mounted on a set of first and second flat panels, each of which is connected to a third panel by means of a bendable web. The first and second panels are arranged in overlapping parallel relation to each other and the third panel by appropriately folding the bendable web. The method of Claim 15 contains

equivalent language. None of the cited references either alone or in combination teach this configuration.

Discussion of the Cited References

The reference Jiang is cited in support of the examiner's rejection based on obviousness. In the system of the cited reference fiber optic transmitter and receiver elements are mounted on two separate parallel boards connected perpendicularly to a base system printed circuit board.

The Examiner agrees that there is no teaching of the use of flexible sheets folded to provide multiple parallel overlapping panels. The panels designed to provide a series of supporting surfaces for electro/optical circuits. The circuit boards 106 and 108 of Jiang are independently mounted in slots 240 on base 205.

In order to remedy the above deficiencies of the teaching of Jiang, the Examiner has cited the reference Brimhall, et al. The system of Brimhall is a hearing aid design which is directed to providing a one size fits all, left and right hand device. Flat substrate 102 is constructed with a series of mounting panels 104-110 extending outward and connected by means of flexible portions, such as 118a. After a sequence of bending operations the mounting panels still extend outward from the substrate in a variety of directions, none of which is overlapping with adjacent panels or the substrate. The first and second panels of the system of this invention are folded over the third panel on opposite sides to form a three layer assembly which is compact. The resulting series of mounting panels of Brimhall probably suit the shape of a generic ear piece, but are certainly do not minimize space has speculated by the Examiner.

This is indicative of the fact that the teachings of Jiang and Brimhall are not compatible, as the packaging goals are significantly different in the two technologies. A person skilled in the art of designing electro-optical devices would not investigate hearing aid designs to improve their product. Applicant submits that a combination of the teachings of Jiang and Brimhall to obtain the connection configuration of the subject invention would not be obvious to one skilled in the art.

The Examiner characterizes the teaching of figures 13-17 of Brimhall as showing:

"the first and second sheets are connected to adjacent sides of a third sheet, the first, second and third sheets being positioned in overlapping parallel relation"

It is clear from a review of figure 17, that mounting region 104 is not overlapping its adjacent mounting region 106, nor is mounting region 110 overlapping its adjacent mounting region 106. In addition mounting region 108 extends outward from the assembly at a 45° angle. The reference Brimhall at most teaches the use of flexible regions, but it gives no teaching as to how to obtain the configuration of the subject invention. The teaching of Brimhall, therefore, does not remedy the deficiencies of the disclosure of Jiang.

The Issue of Obviousness

According to basic tenets of patent law, in order to support an obviousness rejection, there must be some suggestion of the desirability of making the modification, aside from the subject application. The claimed invention must be considered as a whole and the references must suggest the desirability and thus the obviousness of making the modification, the references must be

706.02(a) and 2141. Applicant submits that the modification of the teachings of Jiang and Brimhall in order to obtain the invention, as described in the claims submitted herein, would not have been obvious to one skilled in the art. There is no indication that such a combination would be desirable.

This is supported by the Court of Appeals for the Federal Circuit where it is stated in *Ecolochem v Southern Cal. Edison Co.* decided on September 7, 2000 as follows:

"Our case law makes clear that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the prior art references. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight."

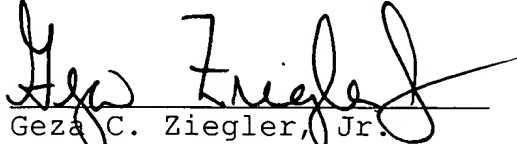
Id. "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998) (citing In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)).

The above arguments apply equally to the rejected dependent claims.

In view of the remarks stated above, Applicant submits that all of the claims under consideration contain patentable subject matter and favorable action by the Examiner is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

A check for \$86 is enclosed for additional claim fee. The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,


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4 June 2004
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